



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 8. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-11 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Part III DETAILED ACTION

Drawings

1. The drawings are objected to because they do not include certain reference signs mentioned in the description. 37 CFR § 1.84(f) states, "Reference signs not mentioned in the description shall not appear in the drawing and vice versa." The following reference signs are not included in the drawings: Reference numbers 28 (note page 6, line 29) and 54 (note page 7, line 11). Correction is required.

2. Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and

b) A print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention.

On page 6, line 29, the specification describes a top or forward end of remote control 10. However, the drawings fail to include reference number 28. On page 7, line 11, reference is made to a backup battery 54 and diode 56. The drawing does not include reference numeral 54, while reference numeral 56 appears to be associated with a battery, not a diode. Similarly, page 7, line 14 refers to a reset circuit 58, while the drawings appear to associate reference numeral 58 with a diode. On page 7, lines 19-20, the specification recites that LED 3 is connected to an input of CPU 44, but FIG. 3 does not show connection as such. Thus, the specification and the drawings are not in agreement. Is the specification correct, or the drawings. For that matter, is either one correct? What is going on here? It is not clear, as the written description is inadequate.

Claim Objections

4. Claims 10 and 11 are objected to because of the following informalities: Claim 11 was misnumbered as claim 10.

Misnumbered claim 10 (i.e. the second claim numbered claim 10) has been renumbered as claim 11.

Claim Rejections - 35 USC § 112

5. Claims 1-11 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the functional recitation that the remote control comprises "code data for executing command functions ... stored in said memory means" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function; and

the functional recitation that the remote control comprises "program means ... keypad" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

In claim 7, the functional recitation that the remote control comprises "code data for executing command functions ... stored in said memory means" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function;

on lines 15-17, 18, 21 and 23-25, it is not clear what performs the determining;

on line 22, it is not clear what performs the setting; and
on lines 26-28, it is not clear what performs the obtaining.

In claim 10, the functional recitation that the remote control comprises "code data for executing command functions ... stored in said memory means" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function; and

it is not clear what the association is between the various "means for" recited on lines 12-29, and the various elements and means recited on lines 2-11 (Are these one and the same, or otherwise?).

In claim 11, the functional recitation that the remote control comprises "code data for executing IR command functions stored in said memory means" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function; and

the functional recitation that the remote control comprises "program means ... keypad" is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

7. The disclosure does not include an adequate written description of the invention so as to provide a proper understanding of thereof; however, the claimed invention is given

its broadest interpretation in conjunction with the disclosure and the prior art.

Therefore, given the 35 U.S.C. § 112 deficiencies set forth above, the claims are accorded their most reasonable interpretation consistent with the specification for their evaluation with respect to the prior art.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-2, 6 and 11 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Kurita.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

12. Claims 3-5 and 7-10 are rejected under 35 U.S.C. § 103 as being unpatentable over Kurita as applied to claims 1-2, 6 and 11 above, and further in view of Osborne et al.

Claims 7 and 10:

Osborne et al. discloses a method of reassigning a function to a key in a calculator which is analogous to the claimed remote control transmitter. Osborne teaches key assignment such as claimed (see FIGS. 2-3; col. 2, line 64 to col. 6, line 42), and Osborne acknowledges that such implementation which advantageously reduces the amount of required storage space (col. 1, lines 58-60). Thus Osborne exemplifies such feature as claimed, although Osborne does not expressly recite application of such implementation in a remote controller.

Serial Number: 07/990,854
Art Unit: 2617

-8-

However, one of ordinary skill in the art would have readily recognized that the key assignment implementation of Osborne would have been highly desirable in the controller exemplified by Kurita, as each concern programming keypads of limited size, and each concern small hand-held microprocessor devices with limited storage space. Thus it would have been obvious to the artisan to utilize the implementation taught by Osborne in the remote controller exemplified by Kurita in order to effectuate key assignment which reduces the amount of required storage space.

Claims 3-5 and 8-9:

It would have been obvious to utilize any appropriate key sequence to enter a programming routine, as desired, since such is conventional in the art.

As such, it would have been further obvious to have the features as claimed.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hill whose telephone number is (703) 305-8967.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Examiner Peng, can be reached at (703) 305-4392. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

ANDREW M. HILL 
PATENT EXAMINER
GROUP 2600

A.H.
October 1, 1994


JOHN K. PENG
SUPERVISORY PATENT EXAMINER
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